



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,547	10/03/2001	Glen Jorgensen	18405-115	1371

30623 7590 07/08/2003

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

SORKIN, DAVID L

ART UNIT	PAPER NUMBER
----------	--------------

1723

8

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/970,547

Applicant(s)

JORGENSEN ET AL.

Examiner

David L. Sorkin

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 20-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-19 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of 1-19 in Paper No. 7 is acknowledged. The traversal is on several grounds, each addressed below:
2. Firstly, applicant argues, regarding Groups I and II that "the invention of Group I requires, in the very least, to be used with a centrifuge". However, the Examiner disagrees. The claims of Group I are apparatus claims, and therefore do not require any particular "use". As held in *In re Casey*, 152 USPQ 235 (CCPA 1967), "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself". Similarly, as held in *Rowe v. Dror*, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997), "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation". Therefor, while claim 1 does mention the possibility of using the claimed apparatus "for" a centrifuge, it is inconsistent with the above decisions to state that the claim "requires" the invention to be used with a centrifuge. The claim could be anticipated by prior art that does not disclose using the apparatus with a centrifuge. For example such an apparatus could be using in a serial arrangement of filters, a serial arrangement of static mixing chambers, an arrangement of catalytic processing chambers or many other fluid treatment situations including and heating and cooling applications.
3. Regarding Groups I and III, the Examiner would like to point out that the "separate utility" discussed in the restriction requirement refers to the connector which is

Art Unit: 1723

Group III, being capable of being used with things other than the apparatus of Group I, which requires axially aligned processing chambers and expressor chambers, each chamber having an axial opening. Applicant does not explain why applicant believes the connector could not be used to connect things other than the apparatus of Group I. Obviously, the connector could be used to connect chambers that have non-axial openings (such as peripheral openings) and/or chambers which are not axially aligned, but are instead substantially off-center with respect to one another.

4. It is considered that Group IV is not open to being a "static" process as applicant suggests, because claim 32 requires "centrifuging the plurality of samples" whereas invention I can be used without "centrifuging" and/or without a plurality of samples.

5. The examiner continues to consider that "a method for independently and simultaneously processing a plurality of samples" comprising a step of "adding a plurality of samples to the plurality of processing chambers" (as required by Group IV) is materially different from just having one sample and serially treating it.

6. The relationship between Groups III and IV is remote. The connector of group III is not even mentioned in the method of Group IV. The connector could be used without "centrifuging" and/or without a "plurality of samples" (both required by Group IV). The connector could be used to connect chambers that have non-axial openings (such as peripheral openings) and/or chambers which are not axially aligned, but are instead substantially off-center with respect to one another.

The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 1723

Drawings

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "terminal hub" must be shown or the feature canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

8. On page 12, line 19 of the specification, "palettes" apparently should read - - platelets - -.

Claim Objections

9. Claim 14 is objected to because it has a period in line 1 after the word "and".

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 4-16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Juhasz et al. (US 3,503,326). Note: regarding claim preamble of claim 1, particularly, the statement of intended use "for a continuous flow centrifuge", it has being held that, "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention,

Art Unit: 1723

the preamble is not a claim limitation" *Rowe v. Dror*, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). Further regarding claim 1, Juhasz ('326) discloses an apparatus comprising a plurality of axially aligned processing chambers (10) and expressor chambers (13), each chamber having an axial opening (see col. 2, lines 41-45; Fig. 1) in fixed arrangement, and a plurality of central hubs (6) disposed in the axial openings, the central hubs constructed and arranged to define passages (7,8) for fluid communication between the chambers and a fluid supply. Regarding claim 2, said processing chambers and said expressor chambers are alternately arranged (see especially Figs. 2 and 3, although the embodiment of Fig. 1 could also be considered "alternately arranged", if the pair of subchambers marked "13", which are in fluid communication, are considered a single chamber). Regarding claim 4, the chambers are flexible and expandable (see col. 3, lines 71-75). Regarding claim 5, the processing and expressor chambers are capable of releasably contacting each other at circumferential portions of the chamber when the expressor chambers are filled with an expressor fluid (see Fig. 1). Regarding claim 6, the central hubs are constructed and arranged to prevent construction of an apparatus having two adjacent processing chambers (see Fig. 1). Regarding claim 7, the central hubs are constructed and arranged to prevent construction of an apparatus having two adjacent expressor chambers see Fig. 1). Regarding claim 8, the central hubs are constructed and arranged to define multiple passage ways (7,8) for fluid communication. Regarding claim 9, the central hubs comprise a number of passages for fluid communication that is at least equal the number of chambers in the apparatus (note the at least three radial passage "8" for

Art Unit: 1723

each hub as seen in, for example, Fig. 1). Regarding claim 10, a plurality of weld rings (the flanged portions of 6) are disclosed. Regarding claim 11, the processing chambers and expressor chambers are substantially the same (generally annular) shape (see drawings). While claim 12, is considered open to being an intended use, since the chambers are intended to change size, the processing chambers being smaller than the expressor chambers is depicted, for example, in Fig. 1. Regarding claim 13, the processing chambers and expressor chambers are substantially circular (see col. 2, line 41). Claims 14 and 15 are open to being intended uses, due to the flexible materials defining the chambers. The processing chambers of Juhasz ('326) may have a smaller diameter than the expressor chambers, as seen in Fig. 1, or the same diameter, as incoming fluid expands the processing chamber, as described in col. 3, lines 71-75). Regarding claim 16, the processing and expressor chambers are constructed from two sheets of flexible material (3 and/or 4) sealed at an outer circumference and an inner circumference, wherein the inner circumference is adjacent the axial opening (see Fig. 1). Claim 18 further requires an "entry hub". The left-most hub 6 in Fig. 1 is considered to anticipate this limitation and is capable of being used to allow entry of fluid from an external pathway as stipulated in the claim. Claim 19 is considered not to further structurally limit the claimed apparatus, because it only recites aspects of a "fluid pathway" which is external to the claimed device (as stipulated by parent claim 18).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1723

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Juhasz et al. (US 3,503,326) in view of Bixler (US 988,854). The apparatus of Juhasz ('326) was discussed above with regard to claim 1. A terminal central hub disposed at a terminus of the plurality of axially aligned processing chambers and expressor chambers to terminate flow through the central hub fluid passages is not explicitly disclosed. Bixler ('854) teaches such a terminal central hub (see uppermost section 3 in Fig. 1). It is considered that it would have been obvious to one of ordinary skill in the art to have provided the apparatus of Juhasz ('326) with a terminal central hub as taught by Bixler ('854), because Juhasz ('326) states in col. 2, lines 32-36, "it will be obvious to those skilled in the art that a filter press may comprises an optional number of such filter frames which are sandwiched between a pair of closing means known per se and, therefore, not shown".

Art Unit: 1723

Allowable Subject Matter

15. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art is Juhasz at al. (US 3,503,326); however, Juhasz ('326) fails to disclose the processing chambers each being within a corresponding expressor chamber.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Application/Control Number: 09/970,547

Page 9

Art Unit: 1723

David Sorkin
David Sorkin

June 30, 2003